

1634

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August 6, 2003

To:
Commissioner for Patents
ATTN: Examiner Betty J. Forman
Group Art Unit No. 1634
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From: Lisa A. Haile, J.D., Ph.D.
 (858) 677-1456 **Client-Matter Number:** 104703-101

Re: United States Continuation-in-Part Patent Application No.: 09/894,956
Entitled: CAPILLARY ARRAY-BASED SAMPLE SCREENING
Filed: June 27, 2001
Inventors: William Michael Lafferty
Our Docket No.: DIVER1280-14

Pages: - 10 - (including this form) Originals: will be mailed will not be mailed

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Message:

Please see attached.

CONFIDENTIALITY NOTICE

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Gray Cary\GT6359811.1
 104703-101

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PATENT
ATTORNEY DOCKET NO.: DIVER1280-14

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: William Michael Lafferty Art Unit: 1634
Application No.: 09/894,956 Examiner: Betty J. Forman
Filed: June 27, 2001 Conf. No. 7268
Title: CAPILLARY ARRAY-BASED SAMPLE SCREENING

Commissioner for Patents
ATTN: Examiner Betty J. Forman
Group Art Unit No. 1634
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL SHEET

Sir:

Transmitted herewith for the above-identified application, please find:

1. Response to Communication mailed July 29, 2003 (3 pages); and
2. Terminal Disclaimer (2 pages).

| | |
|---|--|
| CERTIFICATION UNDER 37 CFR §1.6 (d) | |
| I hereby certify that this paper is being facsimile transmitted to: Commissioner for Patents, ATTN: Examiner Betty J. Forman, Group Art Unit No. 1634, P.O. Box 1450, Alexandria, VA 22313-1450, at the Patent and Trademark Office on the date shown below: | |
| Cecilia Tobin (Name of person transmitting paper) | |
| Cecilia Tobin August 6, 2003 (Signature) (Date) | |

Gray Cary\GTM\6359808.1
104703-101

PATENT
ATTORNEY DOCKET NO.: DIVER1280-14

Applicant: William Michael Lafferty
 Application No.: 09/894,956
 Filed: June 27, 2001

Page 2

Applicants claim **SMALL ENTITY** status in the above-identified application. Pursuant to 37 C.F.R. § 1.27, a verified statement claiming small entity status is not required.

The filing fee is calculated as follows:

| For | Claims Remaining After Amendment | Highest Number Previously Paid For | Extra Claims | Large Entity Rate | Small Entity Rate | Calculations |
|--------------------|----------------------------------|------------------------------------|--------------|-------------------|-------------------|--------------|
| Total Claims | 11 | 43 | 0 | x \$18 | x \$09 | \$.00 |
| Independent Claims | 1 | 9 | 0 | x \$84 | x \$42 | \$.00 |
| Multiple Claims | | | | \$280 | \$140 | \$.00 |
| Basic Filing Fee | | | | \$750 | \$375 | \$.00 |
| | | | | | TOTAL FEE | \$.00 |

The Commissioner is hereby authorized to charge the total fee of \$55.00 for the filing of this Terminal Disclaimer, or may apply any underpayment fees due, or credit any overpayment to Deposit Account No. 50-1355. A duplicate copy of the sheet is enclosed.

Respectfully submitted,


 Lisa A. Haile, J.D., Ph.D.
 Registration No. 38,347
 Telephone: (858) 677-1456
 Facsimile: (858) 677-1465

Date: August 6, 2003

USPTO CUSTOMER NUMBER 28213
GRAY CARY WARE & FREIDENRICH LLP
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PATENT
ATTORNEY DOCKET NO.: DIVER1280-14

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Commissioner for Patents
ATTN: Examiner Betty J. Forman
Group Art Unit No. 1634
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO COMMUNICATION

Sir:

Responsive to the Communication mailed July 28, 2003 indicating that the Response to Office Action filed on May 12, 2003 was not fully responsive to Office Action mailed November 14, 2002, please consider the following remarks:

| | |
|---|--------------------------|
| CERTIFICATION UNDER 37 CFR §1.6 (d) | |
| I hereby certify that this paper is being facsimile transmitted to: Commissioner for Patents, ATTN: Examiner Betty J. Forman, Group Art Unit No. 1634, P.O. Box 1450, Alexandria, VA 22313-1450, at the Patent and Trademark Office on the date shown below: | |
| Cecilia Tobin (Name of person transmitting paper) | August 6, 2003 (Date) |
| <i>Cecilia Tobin</i> (Signature) | |

Gray Cary\GT\6359776.1
104703-101

PATENT
ATTORNEY DOCKET NO.: DIVER1280-14

Applicant: William Michael Lafferty
Application No.: 09/894,956
Filed: June 27, 2001
Page 2

REMARKS

Claims 1-10 and 44 were pending prior to this Response, claims 11-43 have been cancelled without prejudice, and new claim 44 has been added in the Response filed on May 12, 2003. In the present communication no claims have been amended, added or cancelled. Therefore, claims 1-10 and 44 are pending as presented in the Response.

The Double Patenting Rejection

The Examiner states in the Communication that the Response filed on May 12, 2003 is not fully responsive because Applicant did not respond to a provisional obviousness-type Double Patenting Rejection by arguing the rejection or filing a Terminal Disclaimer (Communication, page 2). To overcome the alleged non-responsiveness to the provisional rejection, Applicant submits herewith a Terminal Disclaimer disclaiming the terminal part of any patent that may be granted based on the present application that would extend beyond the grant of any patent that might be granted on co-pending U.S. Patent application Serial No. 09/790,321, filed February 21, 2001. In addition, Applicant submits that the present application and co-pending U.S. Patent Application Serial No. 09/790,321 referenced in the Terminal Disclaimer were co-owned by Diversa Corporation at the filing date of the present application. In view of the Terminal Disclaimer submitted herewith, Applicant respectfully submits that co-pending U.S. Patent Application Serial No. 09/790,321 is not available as prior art against the present application. According, reconsideration and withdrawal of the Double Patenting Rejection are respectfully requested.

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In view of the Terminal Disclaimer and above remarks, Applicants respectfully submit that at all rejections have been overcome and allowance of claims 1-10 and 44 is respectfully requested.

If the Examiner would like to discuss any of the issues raised in the Office Action, Applicant's representative, Lisa A. Haile, J.D., Ph.D., can be reached at (858) 677-1456.

Respectfully submitted,


Lisa A. Haile, J.D., Ph.D.
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USPTO CUSTOMER NUMBER 28213
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San Diego, California 92121-2133

Enclosure: Terminal Disclaimer

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